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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,057	02/26/2002	Antoine F Carpentier	249326USOX PCT	4658
22850	7590	06/22/2007		
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER ZARA, JANE J	
			ART UNIT 1635	PAPER NUMBER
			NOTIFICATION DATE 06/22/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/937,057

Applicant(s)

CARPENTIER, ANTOINE F

Examiner

Jane Zara

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 28 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
Please see attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

J Zara TC1600
JANE ZARA, PH.D.
PRIMARY EXAMINER

Attachment

The Advisory Action mailed 4-19-07 is hereby vacated and replaced with the Advisory Action set forth herewith.

Claim Rejections - 35 USC § 112

Claims 52, 54-57 and 59-63 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record set forth in the Office action mailed 1-19-07.

Claims 52 and 67, lines 1-2, recite an "oligonucleotide consisting of 20-100 nucleotides or base pairs." Since the claims recite comprising language, it is still unclear whether the oligonucleotide claimed comprises a self-complementary (double stranded) oligonucleotide, or an oligonucleotide and its complementary strand. The metes and bounds of the claimed invention cannot be determined. For this reason, the instant rejection is maintained.

Claim Rejections - 35 USC § 102

Claims 52, 53, 63 and 66-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Clark et al for the reasons of record set forth in the Office action mailed 1-19-07.

Applicant argues that Clark is silent with regard to the methylation of the CG bases and therefore does not properly anticipate the instantly claimed invention.

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Clark teaches an oligonucleotide between 20 and 100 nucleobases in length comprising nucleotides 9-16 of SEQ ID no. 9, which oligonucleotide is optionally double or single stranded (see the accompanying sequence alignment data between the Accession No. BI881470 of Clark et al and the instantly claimed oligonucleotide).

Contrary to Applicant's assertions, expression of unmethylated sequences is an inherent teaching of Clark. Unmethylated nucleotide sequences are commonly expressed in various laboratory scenarios, including by chemically synthesizing small nucleic acids, or expressing oligonucleotides in bacteria or mammalian cells under non-methylating conditions (e.g. by choosing proper cell lines for expression). Furthermore, there is no guarantee that all CG sequences are methylated even under conditions where methylation is desired. So, absent evidence to the contrary, one would expect that the sequence disclosed by Clark would inherently contain non-methylated CG motifs. For these reasons, the instant rejection is maintained.

Double Patenting

Claims 59-62 and 69 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 15-19 and 23-26 of application No. 09/967,881 (claims 1-9 of U.S. Patent No. 7,108,844) the reasons of record set forth in the Office action mailed 1-19-07. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to methods of treating cancer

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comprising the administration of an oligonucleotide between 20-100 nucleobases
in length and comprising SEQ ID No. 51.

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